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THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: M.H. Wyzgala et al.

Attorney Docket No.: BSCO114052

Application No.: 09/629,771

Group Art Unit: 3762

Filed: July 31, 2000

Title: EXPANDABLE ABLATION BURR

REQUEST FOR RECONSIDERATION OF PETITION UNDER 37 C.F.R. 1.47(a)

Seattle, Washington 98101

February 25, 2002

TO THE COMMISSIONER FOR PATENTS:

We, Mark H. Wyzgala, Thomas J. Hiblar, Lixiao Wang, John Chen, Irina Nazarova, Nancy Haig, Sheng-Ping Zhong, and Daniel M. Lafontaine (hereinafter "the Petitioners"), as Applicants of patent Application No. 09/629,771 (hereinafter "the Application"), hereby request reconsideration of our petition Under 37 C.F.R. § 1.47(a) to accept the Declarations without signature of joint applicant, Eric B. Hamilton.

REMARKS

The Petitioners filed a Petition Under 37 C.F.R. § 1.47(a) with a certificate of mailing date of March 23, 2001 (hereinafter "the Petition") to accept the Declarations without signature of joint applicant, Eric B. Hamilton. Filed concurrently with the Petition were a petition for a four-month extension of time and the required fee, a declaration executed by 8 of 9 joint inventors, the surcharge for filing "Missing Parts", the Application filing fees, and the Petition fee. A declaration of facts of Susan L. Creek, a patent legal secretary, accompanied the petition.

A grantable petition under 37 C.F.R. 1.47(a) requires: (1) a petition including proof of the pertinent facts establishing that the joint inventor(s) refuses to join, or cannot be found or reached after diligent effort; (2) a proper Oath or Declaration executed by the available joint inventor(s); (3) the fee of \$130.00 as specified in 37 C.F.R. § 1.17(h); and (4) the last known address of the omitted inventor(s).

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OFFICE OF PETITIONS
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The Petition was dismissed in a Decision Refusing Status Under 37 C.F.R. 1.47(a) mailed on October 24, 2001 (hereinafter "the Decision"). The Decision asserts that the Petition lacks items (1), (2), and (4) stated above. As will be described in detail below, the Petitioners respectfully assert that each deficiency stated in the Decision has been addressed and is satisfied by this Request for Reconsideration of Petition Under 37 C.F.R. § 1.47(a). Accordingly, the Petitioners respectfully request the Request for Reconsideration of Petition Under 37 C.F.R. § 1.47(a) be granted and that the above-referenced patent application be deemed complete for Examination Under 35 U.S.C. 111(a).

(1) A Petition Including Proof of the Pertinent Facts Establishing That the Joint Inventor(s) Refuses to Join, Or Cannot Be Reached After Diligent Effort

The Decision asserts that the Petitioners have failed to establish that the inventor has refused to sign the declaration. The Decisions states that proof of the events should be made by a statement of somebody with first hand knowledge of the events. The Office requires that the non-signing inventor be provided with a complete copy of the Application as filed. This includes the specification with claims, drawings, if any, and a Declaration. The Decision asserts that Ms. Creek's statement of facts does not establish that a complete copy of the Application was mailed to Mr. Hamilton's last known address. The Decision submits that when the Petitioners can show that Mr. Hamilton was mailed or received the Application as filed, and that he either refused to sign the Declaration or would not respond to the request that he sign the Declaration, the Petitioners will have satisfied this requirement.

The Petitioners respectfully assert that Mr. Hamilton was mailed the Application as filed and that he either refused to sign the Declaration or would not respond to the request that he sign the Declaration. Submitted herewith is a Declaration by Luke Dohmen, Chief Patent Counsel, Cardiology, of SCIMED Life Systems, Inc. which sets forth facts specific to Mr. Hamilton's refusal to execute the Declaration. SCIMED Life Systems, Inc., assignee of the Application,

maintains a standard patent practice regarding the execution of a Declaration/Power of Attorney by SCIMED Life Systems, Inc. inventors. More specifically, each inventor is sent a copy of the patent application as filed, along with the Declaration/Power of Attorney and Assignment for execution. (Paragraph 4 of the Declaration of Luke Dohmen)

The Declaration was prepared with a known address of Mr. Hamilton of 19306 Bothell Way N.E., Apt. 101, Bothell, Washington 98011. The Decision notes that the address for Mr. Eric B. Hamilton on the submitted Declaration is not one of the addresses to which Ms. Creek sent the copies of the Declaration and the reminder letters. Accordingly, the Office would like a statement from the Petitioners that the address on the Declaration for Mr. Hamilton was indeed a prior address for him. In response to this inquiry, the Petitioners respectfully submit that the address of 19306 Bothell Way N.E., Apt. 101, Bothell, Washington 98011 for Eric B. Hamilton stated on the Combined Declaration/Power of Attorney submitted March 23, 2001, is a prior known address for Eric B. Hamilton. (Paragraph 2 of the Declaration of Luke Dohmen)

In accordance with the standard patent practice of SCIMED Life Systems, Inc. regarding the execution of a Combined Declaration/Power of Attorney, the letter dated January 11, 2001, from Susan L. Creek, Patent Legal Secretary to Luke Dohmen, to Eric B. Hamilton at his last known address of 818 17th Street, Washougal, Washington 98671, included a copy of the Combined Declaration/Power of Attorney, an Assignment, and a full copy of the Application as filed. (Paragraph 5 of the Declaration of Luke Dohmen)

After failing to receive an executed Combined Declaration/Power of Attorney from Eric B. Hamilton, a reminder letter dated March 20, 2001, from Luke Dohmen was sent to Eric B. Hamilton at his last known address of 818 17th Street, Washougal, Washington, 98671. The March 20, 2001, letter included a copy of the Combined Declaration/Power of Attorney, an Assignment, and full copy of the Application as filed. (Paragraph 6 of the Declaration of Luke Dohmen)

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As of the date of this Request for Reconsideration of Petition Under C.F.R. 1.47(a), SCIMED Life Systems, Inc., or Petitioners' attorney have not received a signed Declaration/Power of Attorney by Eric B. Hamilton for the Application. (Paragraph 7 of the Declaration of Luke Dohmen)

Thus, the Petitioners assert that Eric B. Hamilton was mailed a complete copy of the Application as filed, along with the Declaration/Power of Attorney and Assignment for their execution and that Eric B. Hamilton is refusing to sign the Declaration/Power of Attorney for the Application. Accordingly, the Petitioners respectfully submit that item (1) of 37 C.F.R. 1.47(a) has been satisfied.

(2) A Proper Oath or Declaration Executed by the Available Joint Inventor(s)

The Decision asserts that an Oath or Declaration for the Application in compliance with 37 C.F.R. 1.63 and 1.64 still has not been presented. Specifically, the Decision asserts that the Declaration contains a non-initialed, non-dated alteration to inventor Hiblar's name. In support of this assertion, 37 C.F.R. 1.52(c) states that "any interlineation, eraser, cancellation or other alteration of the application papers filed should be made on or before the assigning of the accompanying oath or Declaration pursuant to C.F.R. 1.63" Thus, the Request for Reconsideration of Petition Under C.F.R. 1.47(a) must include an Oath or Declaration in compliance with 37 C.F.R. 1.63 and 1.64 executed by the Rule 1.47 applicants on behalf of Mr. Eric B. Hamilton.

To satisfy this requirement, submitted herewith is a new executed Declaration/Power of Attorney for the Application from Thomas J. Hiblar, executed on December 4, 2001. Therefore, the Petitioners respectfully submit that the new submitted Declaration of Thomas J. Hiblar, along with the Declarations of the other joint inventors submitted with the Petition on March 23, 2001, satisfies this requirement.

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(4) The Last Known Address of the Omitted Inventor(s)

The Decision asserts that a clear statement of Eric B. Hamilton's last known address is missing, and is required. Accordingly, the Petitioners respectfully submit that the last known address for Eric B. Hamilton is 818 17th Street, Washougal, Washington 98671. (Paragraph 3 of the Declaration of Luke Dohmen)

CONCLUSION

The Petitioners respectfully assert that the Request for Reconsideration of Petition Under 1.47(a) addresses and satisfies each deficiency stated in the Decision. Accordingly, the Petitioners respectfully request the Request for Reconsideration of Petition Under 37 C.F.R. § 1.47(a) be granted and that the above-referenced patent application be deemed complete for Examination Under 35 U.S.C. 111(a).

If the Office has any further questions regarding this Request for Reconsideration of Petition Under 37 C.F.R. § 1.47(a), it is invited to call the Petitioners' attorney at the number listed below.

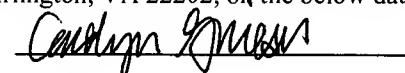
Respectfully submitted,
CHRISTENSEN O'CONNOR
JOHNSON KINDNESS^{PLLC}



Brandon C. Stallman
Registration No. 46,468
Direct Dial No. 206.695.1708

I hereby certify that this correspondence is being deposited with the U.S. Postal Service in a sealed envelope as first class mail with postage thereon fully prepaid and addressed to the Box DAC, Commissioner for Patents, U.S. Patent and Trademark Office, P.O. Box 2327, Arlington, VA 22202, on the below date.

Date: February 25, 2002



BCS:cg

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: M.H. Wyzgala et al. Attorney Docket No.: BSCO114052
Application No.: 09/629,771 Group Art Unit: 3762
Filed: July 31, 2000
Title: EXPANDABLE ABLATION BURR

DECLARATION OF LUKE DOHmen IN SUPPORT OF APPLICANTS' REQUEST FOR
RECONSIDERATION OF PETITION UNDER 37 C.F.R. § 1.47(a)

Seattle, Washington 98101

February 25, 2002

TO THE COMMISSIONER FOR PATENTS:

I, Luke Dohmen, declares that:

1. I am employed as Vice President and Chief Patent Counsel, Cardiology, for SCIMED Life Systems, Inc., having an address of 1 SCIMED Place, Maple Grove, MN 55311, assignee of Application No. 09/629,771 (hereinafter "the Application"). I make this declaration in support of Applicants' Request for Reconsideration of Petition under 37 C.F.R. § 1.47(a).
2. The address of 19306 Bothell Way NE, Apt. 101, Bothell, Washington 98011 for Eric B. Hamilton on the Combined Declaration/Power of Attorney submitted March 23, 2001, is a known prior address for Eric B. Hamilton.
3. Currently, the last known address for Eric B. Hamilton is 818 17th Street, Washougal, Washington, 98671.
4. Our standard patent practice regarding the execution of a Declaration/Power of Attorney by our inventors is to send a copy of the patent application as filed to the inventor(s), along with the Declaration/Power of Attorney and Assignment.
5. In accordance with our standard patent practice regarding the execution of a Combined Declaration/Power of Attorney described in paragraph 4 of this Declaration, the letter

dated January 11, 2001, from Susan L. Creek, my patent legal secretary, to Eric B. Hamilton at his last address of 818 17th Street, Washougal, Washington, 98671, of which a true and correct copy is attached as Exhibit 1, included a copy of the Combined Declaration/Power of Attorney, an Assignment, and a full copy of the Application as filed.

6. In accordance with our standard patent practice regarding the execution of a Combined Declaration/Power of Attorney described in paragraph 4 of this Declaration, the letter dated March 20, 2001, I sent to Eric B. Hamilton at his last address of 818 17th Street, Washougal, Washington, 98671, of which a true and correct copy is attached as Exhibit 2, included a copy of the Combined Declaration/Power of Attorney, an Assignment, and a full copy of the Application as filed.

7. As of this 25th day of February, 2002, I have not received a signed Declaration by Eric B. Hamilton for the Application.

8. All statements made herein of my own knowledge are true and all statements made on information and belief are believed to be true, and further, these statements are made with the knowledge that willful, false statements and the like so made are punishable by fine or imprisonment or both under § 1001 of Title 18 of the United States Code, and that such willful, false statements may jeopardize the validity of the application or any patents issuing thereon.

Date: February 25, 2002



Luke Dohmen
Vice President and
Chief Patent Counsel, Cardiology



January 11, 2001

Boston Scientific Scimed, Inc.
One Scimed Place
Maple Grove, MN 55311-1566
763.494.1700
www.bsci.com

Eric B. Hamilton
818 17th Street
Washougal, WA 98671

RE: U.S. Patent Application for:
EXPANDABLE ABLATION BURR
Our File No.: HT-P0033-US03

Dear Eric:

Thank you for your phone call.

Enclosed please find a Combined Declaration/Power of Attorney and an Assignment for the above-identified patent application. Please sign both forms where indicated and return to me as soon as possible. Please note that the Assignment document needs to be notarized.

Thank you for your prompt attention and assistance in this matter.

Sincerely,

A handwritten signature in cursive script that appears to read "Susan L. Creek".

Susan L. Creek
Patent Legal Secretary

Enclosures



March 20, 2001

Scimed Life Systems, Inc.
One Scimed Place
Maple Grove, MN 55311-1566
612.494.1700
www.bsci.com

Eric B. Hamilton
818 17th Street
Washougal, WA 98671

FEDERAL EXPRESS

RE: U.S. Patent Application for:
 EXPANDABLE ABLATION BURR
 Our File No.: HT-P0033-US03

Dear Eric:

After sending several letters regarding the above-identified file, we can only assume that you are refusing to sign the formal documents. Therefore, we will be sending an Affidavit to the Patent Office along with the formal papers stating that we have not been able to obtain your signature.

If you are willing to sign the documents, please do so immediately and return them to my attention. In addition, please fax a copy to my attention at (763) 494-2180.

I am enclosing another copy of the papers and another return Federal Express envelope and label for your convenience.

Thank you for your prompt attention and assistance in this matter.

Sincerely,

A handwritten signature in black ink, appearing to read "Luke Dohmen".

Luke Dohmen
Vice President and Chief Patent
Counsel, Cardiology

Enclosures